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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/244,043	02/04/1999	HIRONORI KANNO	826.1535/JDH	3301

21171 7590 12/17/2004

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EXAMINER

SHAH, SANJIV

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/244,043

Applicant(s)

KANNO ET AL.

Examiner

Sanjiv D. Shah

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10,12-14,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10,12-14,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3-10, 12-14, 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically claims 12, 13, 14 and 17 recites a feature of “*upon determining that the browser is not connected to Internet*” which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No determination step is carried out or how determination is made is not in the specification. Specification merely states on page 10, line 21-24 that “a browser need not be connected to the internet at that occasion so that a presentation can refrain from being interrupted by a connection failure”. However no determination step is included. Therefore it is a new matter and should be removed.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 3-10, 12-14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bretschneider et al (6,008,807) in view of Mantha et al., (USPAT 6,163,779).

With respect to independent claim 17, and dependent claims 3-5 and 10, Bretschneider discloses a "slide show presentation system"—refer to Bretschneider's abstract. Bretschneider describes Microsoft Corporation's "PowerPoint" application. Bretschneider further discloses:

"browser unit to obtain web page information using URL address information defined on an information network, and to output the obtained information" and "storage unit to store a predetermined correspondence relationship between a plurality of pieces of address information of web page information and a plurality of sequence numbers

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representing a predetermined output sequence" at abstract (*browser mode*), figure 1, column 3 (line 65) through column 4 (line 23), and column 6 (lines 44-58).

Bretschneider discloses the computer used to execute the slide presentation program (columns 3-4). Bretschneider discloses a *permanent storage medium 108* for storing the program and slide data. Refer also to Bretschneider's column 6 (lines 44-58), in which he discloses retrieving slide presentations from the Internet (hence, "web page information . . . defined on an information network").

"control unit to increment a control variable indicating one of the sequence numbers . . . ". Refer to Bretschneider's figures 9A-9C and column 10 (bottom) through column 13. (Note: there is a typographical error at the bottom of column 10—"6A-6C" should read "9A-9C".) Specifically, refer to Bretschneider's column 11 (lines 28-33), in which he discloses *allow a slide presentation author to select slides that are to be included in the slide show*. Bretschneider allows the user to customize the slide show to include selected slides.

It is noted that Bretschneider fails to explicitly teach the "user-specified correspondence relationship between . . . address information and . . . sequence numbers". However, such a teaching would have been obvious to one of ordinary skill in the art at the time of the invention in view of Bretschneider's teaching of the custom presentation (figure 9A (922), column 11) because the user can choose which slides and in what sequence. Thus, there is an implied correspondence between the address of the slide and the "sequence number". In other words, the order of presentation of the slides implies the claimed "sequence numbers".

Furthermore, Bretschneider does not teach the two added features: first, that the storage unit is a bookmark storage unit; and second, that the determination is made that the browser is not connected to the Internet when presenting the web page. The broadest reasonable interpretation in view of 112 first rejection above is that the browser is not connected to Internet.

Nevertheless, the missing feature is taught by the prior art of Mantha. Mantha teaches the technology for "making a local copy of a Web page to facilitate client-side browsing of the page content (col.1, line 7). Mantha teaches that "copying or 'saving' a Web page onto a local storage to enable a user to browse the page at a subsequent time (col.1, line 62). Furthermore, Mantha teaches creating a bookmark storage storing the correspondence relationship between a plurality of pieces of address information of web page information and a plurality of sequence information (col. 2, lines 12-44). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated the feature of Mantha into Bretschneider, since Mantha explicitly provided the motivation by teaching that the offline web page viewing technology allows the user to view the snapshot of the web site at any given point in time, and also allows the user to view the pages over and over again at later times (col.1, lines 40-55).

With respect to dependent claims 6-7, refer to Bretschneider's column 11 (lines 33-41). Bretschneider teaches optionally using preset timings to automatically advance slides in the slide show. As per claim 7, it is noted that Bretschneider does not explicitly

teach “changes the time intervals according to each of the plurality of sequence numbers”. Bretschneider does teach “*Using timings*”. It is noted that this term is plural, i.e., timings—not timing. Thus, it appears that Bretschneider teaches separate time intervals for individual slides. However, even if this were not the case, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide variable time intervals because it was well known at the time of the invention that some slides could be skimmed over quickly, while others would warrant more time.

With respect to dependent claims 8-9, refer to Bretschneider’s column 11 (lines 11-27), in which he discloses narrations. It is noted that Bretschneider fails to teach “music”. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include “music” because “narrations” broadly reads on any audio annotation, including music or other sound effects. Since Bretschneider allows for narrations, then a sound card is implied, which indicates that other forms of audio annotation would be possible (and desirable, depending on what the user would want to include in the presentation).

With respect to dependent claim 16, Bretschneider’s disclosure of automatic advancement via predetermined time intervals provides a teaching of “does not require manual advancement”—column 11, lines 33 et seq.

With respect to independent claims 12-14, refer to the rationale relied upon in rejecting independent claim 17. Claims 12 and 13 are essentially directed to “computer-readable storage medium, which stores a program for causing a computer to perform” steps corresponding to the functions set forth in claim 17. Claim 14 is a “slide show method” for preparing and presenting a slide show that essentially corresponds with the functions set forth in claim 17.

Response to Arguments

3. Applicant's arguments filed 9/20/2004 have been fully considered but they are not persuasive.

Applicant argues that the cited references does not teach connection determination as claimed. Examiner disagrees. The specification does not teach determining step. The broadest reasonable interpretation is that “when there is no Internet connection”, which is taught by Mantha as described in the body of the rejection.

Applicant also argues that the correspondence between a slide address and sequence number is not implies because the cited prior art fails to teach how to make a custom show. Examiner disagrees. As specifically cited in the body of the rejection, Bertschneider does teach a custom presentation (figure 9A (922), column 11) through which the user can choose which slides and in what sequence. Applicant's example is one approach of customization and is applicant's opinion on how Bertschneider may be interpreted. Examiner disagrees with applicant's opinion.

Applicant further argues that the cited references are non-analogous art. Examiner disagrees. Both the art are in the same technological area and they are analogous.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (571)272-4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571)272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanjiv D. Shah
Primary Examiner
Art Unit 2176

S. Shah
December 12, 2004